



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Berenice Y. Reed-Gitomer  
Charles Y.C. Pak

Serial No.: 09/339,352

Filed: June 23, 1999

For: ABSORPTIVE HYPERCALCIURIA  
LOCUS ON CHROMOSOME 1

Group Art Unit: 1653

Examiner: H. Robinson

Atty. Dkt. No.: UTSD:553/MBW

*17*  
**PATENT**  
*Supple*  
*Appeal*  
*Brief*

**CERTIFICATE OF MAILING**  
37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below:

November 2, 2001  
Date

*MBW*  
Mark B. Wilson

**RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH 37 CFR § 1.192(c)  
AND SUBMISSION OF SUBSTITUTE APPEAL BRIEF**

**BOX AF**  
Commissioner of Patents  
Washington, D.C. 20231

Sir:

Appellants hereby submit this Response to the Notification of Non-Compliance with 37 C.F.R. § 1.192(c) mailed October 2, 2001, for which the date for response is November 2, 2001. It is believed that no fees under 37 C.F.R. §§ 1.16 to 1.21 are occasioned by the filing of this paper; however, should the Commissioner determine otherwise, the Commissioner is hereby authorized to deduct said fees from Fulbright & Jaworski Deposit Account No. 50-1212/10017634/MBW.

Appellants strenuously object to the statements contained within the Notification of Non-Compliance with 37 C.F.R. § 1.192(c), and are not pleased with the unnecessary delay and expense caused by it.

The Notification cites two reasons for alleging non-compliance, neither of which are true with regard to the originally filed Appeal Brief, both of which Appellants believe to be entirely unfounded and without merit.

The first ground of “non-compliance” was that Appellants did not explain why claim 2 was believed to be separately patentable over the remainder of the claims, as required by MPEP § 1206. The Examiner points to the “Grouping of the Claims” section of the original Appeal Brief, stating that it “only pointed out the differences between claim 1 and 2 (sic).” This is not the case. In its entirety, this section of the original Appeal Brief reads:

For purposes of this Appeal, the claims should stand or fall separately, as described below.

For the purpose of the rejection under 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph, claim 2 should stand or fall separately from the remainder of the claims. Claim 2 is directed specifically to the determination of whether or not an individual has an increased risk of developing absorptive hypercalciuria, instead of hypercalciuria of any form. The majority of the data in the specification and the Declaration of Charles Y.C. Pak and Berenice Y. Reed-Gitomer, submitted as Appendix B herewith, relates specifically to an increased risk of absorptive hypercalciuria. These data are discussed below. Therefore, although Applicants submit that such a determination would not be supported by the facts of this case, the Board could determine that a claim of the scope of present claim 1, is properly rejected under 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph, while a claim limited in scope to absorptive hypercalciuria is not properly rejected under these grounds.

Appellants do not see how this section can be stated to “merely point out the differences in what the claims cover,” in the manner in which that phrase is used in MPEP § 1206(c)(7). Rather, it specifically addresses reasons why the Board could determine that the rejections under

35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph, should be decided differently for claim 1 and claim 2.

Additionally, even if the Grouping of the Claims section were not adequate to meet the standards of MPEP § 1206, the Examiner apparently completely ignored other portions of the original Appeal Brief, which even further elaborated as to why claims 1 and 2 could be separately patentable. For example, Appellants addressed that issue with regard to the rejection under 35 U.S.C. § 101 in the paragraph bridging pages 9 and 10 of the original Appeal Brief, which reads:

In addition to the above arguments, which apply to all of the claims, Applicants further assert that the subject matter of current claim 2 has utility for even additional reasons. Claim 2 is directed specifically to determining whether or not one has an increased risk of absorptive hypercalciurea, the specific form of hypercalciurea about which the inventors have gathered the most information. Although Appellants submit that they have shown that the invention has utility in regard to determining whether or not one has an increased risk of hypercalciurea in general, it is possible that the Board could disagree with this broad of a utility. However, Appellants submit that there are additional and compelling arguments for the utility of the subject matter of claim 2, since all of the mutations which have been found to result in hypercalciurea have also been specifically linked to absorptive hypercalciurea. Therefore, even if the Board does not find the subject matter of claim 1 to have utility, the subject matter of claim 2 should be found to have utility.

Likewise, Appellants specifically addressed the issue of why claim 2 should stand or fall separately from the remainder of the claims with regard to the rejection under 35 U.S.C. § 112 in the paragraph bridging pages 13 and 14 of the original Appeal Brief, which reads:

In addition to the above arguments, which apply to all of the claims, Applicants further assert that the subject matter of current claim 2 is enabled for even additional reasons. Claim 2 is directed specifically to determining whether or not one has an increased risk of absorptive hypercalciurea, the specific form of hypercalciurea about which the inventors have gathered the most information. Although Appellants submit that they have shown that the invention is enabled in regard to determining whether or not one has an increased risk of hypercalciurea in general, it is possible that the Board could disagree with this broad of

enablement. However, Appellants submit that there are additional and compelling arguments for the enablement of the subject matter of claim 2, since all of the mutations which have been found to result in hypercalciurea have also been specifically linked to absorptive hypercalciurea. Therefore, even if the Board does not find the subject matter of claim 1 to be enabled, the subject matter of claim 2 should be found to be enabled.

Based on these three separate portions of the original Appeal Brief, each of which address why claim 2 should stand or fall separately from the remainder of the claims, Appellants strenuously disagree with the Examiner's assertion that they have not met the requirements of 37 CFR § 1.192 or MPEP § 1206.

The second alleged ground of non-compliance asserted by the Examiner was that the original Appeal Brief did not, in the Status of the Claims section "list the claims under appeal, just pointed (sic) to Appendix A." Appellants disagree with this application of MPEP § 1206(c)(3), which reads: "*Status of the Claims.* A statement of the status of all the claims, pending or cancelled, and **identifying the claims appealed.**" (Emphasis added.)

The "Status of the Claims" section of the original Appeal Brief reads:

Claims 1-26 were originally filed in the present application. During prosecution, claims 8-9, 16 and 18-26 were cancelled and claims 1, 10, 11 and 12 were amended. Appendix A contains the claims under appeal in what Appellants believe to be the correct status.

Appendix A of the original Appeal Brief contained claims 1-7, 10-15, and 17. Appellants do not see how the original Appeal Brief was defective in terms of MPEP § 1206(c)(3). The original Appeal Brief clearly identified the claims appealed by reference to Appendix A. There is absolutely nothing in MPEP § 1206(c)(3) that requires a "list" of the claims under appeal. The requirement of MPEP § 1206(c)(3) exists so that the record on appeal will be clear as to which

claims are on appeal. The original Appeal Brief clearly sets forth which claims were on appeal, and the suggestion that Appellants did not comply with MPEP § 1206(c)(3) is clearly improper.

Despite the above, which Appellants feel would provide more than adequate grounds for petitioning for entry and consideration of the original Appeal Brief, Appellants have determined that the most expeditious manner in which to proceed in this case is to file the Substitute Appeal Brief submitted herewith, which is not susceptible to even the strained readings of 37 CFR § 1.192 and MPEP § 1206 taken by the Examiner.

Entry and consideration of the Substitute Appeal Brief is respectfully solicited.

Respectfully submitted,



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Date: November 2, 2001